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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,451	01/30/2001	Farrukh S. Najmi	SUNIP817	3454
22434	7590	08/25/2006	EXAMINER	
BEYER WEAVER & THOMAS, LLP			ALPERT, JAMES M	
P.O. BOX 70250			ART UNIT	
OAKLAND, CA 94612-0250			PAPER NUMBER	
			3693	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/774,451	NAJMI, FARRUKH S.	
	Examiner	Art Unit	
	James Alpert	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following communication is in response to Applicant's amendment filed on 06/08/2006.

Status of Claims

In the non-final Office Action mailed 03/09/2006, Claims 1-33 were rejected as being unpatentable over Mandler, U.S. Patent #5732400, in view of Bhatt et al, U.S. Patent #6405191. In response, Claims 1,16,22-23 are currently amended. Claims 2-3,12,24-33 are submitted as either previously presented or previously amended, while Claims 4-11,13-15,17-21 are submitted in their original form. Claims 1-33 are thus currently pending.

Response to Arguments

MPEP §714.02 states:

(b) In order to be entitled to reconsideration or further examination, the applicant ... must reply to the Office action. The reply by the applicant ... must be reduced to a writing, which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.

(c) In amending in reply to a rejection of claims in an application, the applicant ... must clearly point out the patentable novelty, which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant ... must also show how the amendments avoid such references or objections.

In the current submission, Applicant simply alleges that the current amendments are not taught by the Mandler and Bhatt references. The Examiner disagrees with this assertion, as discussed below, but also would point out that by failing to traverse the arguments presented in the Office Action, Applicant is in effect admitting that the cited art discloses the limitations of the claims to which they are applied.

In any event, Applicant's amendments have been fully considered but are not persuasive. Therefore, Claims 1-33 remain rejected, and in addition, a new ground of rejection, necessitated by Applicant's amendment, is presented below. Applicant's request for allowance is respectfully declined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 1 recites the phrase "the first plurality of e-business entities..." in the first limitation. There is insufficient antecedent basis for this limitation in the claim since a "first plurality" has yet to be introduced, so the modifier "the" is inappropriate. The claim is confusing and appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of 35 U.S.C. §103, which is not included in this action, can be found in a prior Office action. Claims 1-33 remain rejected as being unpatentable over Mandler in view of Bhatt, et al.

Before addressing each of the claims individually, the examiner would like to address an issue arising out of the use of a "wherein" clause. MPEP §2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

(A) "adapted to" or "adapted for" clauses;

(B) "wherein" clauses; and

(C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.

In the instant set of claims, Applicant recites several steps to be performed followed by a "wherein" clause suggesting a particular system for implementation of the steps. It is the examiner's opinion that the structure of Applicant's system, described using expressive language (e.g. "query manager interface"), does not represent the essential concepts of the invention, and as such these limitations are treated as suggestions. Still the references, do in fact, disclose the required structure, if not by the exact name as detailed by Applicant, then by a similar functionality.

In the previous non-final Office Action, the Examiner described how some of the limitations of Applicant's independent claims ("plurality of enterprise communication protocols" and "first entity is not required to know...") were inherent to a Mandler/Bhatt combination. These arguments are not repeated here, but are given as true, in that the rejections are not traversed. Please refer to the Office Action mailed on 03/09/2006.

Then specifically with regard to Claims 1,16,22 Mandler teaches a buyer/seller/broker intermediary system & method wherein buyers place Request for Quotes (FRQ) with a broker who then forwards the information to a plurality of sellers for consideration and response. See (Col. 3, lines 48-58). Mandler does not expressly teach the publish/subscribe system & method described by the Applicant, however this an old and well-known process exemplified by Bhatt. Bhatt discloses the following:

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subscribing to a service interface by the certain one of the first plurality of e-business entities operating on a plurality of enterprise communication system protocols;
(Col. 5, lines 48-52)

wherein the service interface contains a list of second plurality of e-business entities
(Col. 3, lines 6-15; Col. 14, lines 6-45)

and wherein a subscription is created which is in communication with a broker via a query manager interface (Col. 14, lines 6-45)

publishing the message to the broker by the first entity, the broker being in communication with the service interface via the query manager interface;
(Col. 2, line 64 – Col. 3, line 5; Col. 14, lines 6-45)

determining the selected ones of the plurality of e-business entities to receive the message by the broker; and
(Col. 3, line 66 – Col. 4, line 3)

publishing the message to the selected ones of the plurality of entities based upon the determining. (Col. 11, lines 56-66)

multicasting the message to the selected ones of the plurality of e-business entities based upon the determining by the broker, such that the first entity is not required to know any one of the plurality of enterprise computer system protocols.
(Col. 11, lines 56-66)

Also, for each of the six (6) limitations above, see generally (Bhatt, Claims 1-2).

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to a publish/subscribe method. The motivation for such a combination can be found in both references. In Bhatt, the use of the publish/subscribe system is contemplated for the electronic commerce arts at (Bhatt, Col. 1, lines 24-28), which describes how the nature of business events triggers the system. More importantly, however, Mandler suggest using improved computer technologies at (Col.2, line 65 – Col. 3, line 29) to reduce

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distribution cost, expand markets for sellers, and allowing buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

With regard to Claims 2,21,23 in terms of initial limitation, as well as the last limitation, comprising:

setting an expiration time for the published message after receiving the published message from the first entity;

purging the message when the expiration period lapses.

the Examiner observes that an expiration time is an inherent aspect of publish/subscribe system and method. Bhatt and Mandler do not expressly teach this limitation, however it would be considered part of the teachings of Mandler/Bhatt combination. Bhatt does disclose the remaining two limitations:

retaining the published message;
(Col. 11, lines 62-66)

determining if an appropriate one of the plurality of entities has subsequently subscribed to the service interface so as to be identified to receive the message;
(Col. 12, lines 2-8)

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to sorting out new subscriber/sellers. The motivation for such a combination can be found in both references. In Bhatt, the use of the publish/subscribe system is contemplated for the electronic commerce arts at (Bhatt, Col. 1, lines 24-28), which describes how the nature of business events triggers the system. More importantly, however, Mandler suggest using improved computer technologies at (Col.2, line 65 – Col. 3, line 29) to

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reduce distribution cost, expand markets for sellers, and allowing buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

With regard to Claims 3,17,24 Mandler teaches the system & method comprising:

receiving the message through a multicast protocol at each of the selected ones of the plurality of entities; (Col. 4, lines 25-29)

reviewing the message at each of the selected ones of the plurality of entities; (Col. 4, lines 29-31, which implicitly contains a review of the RFQ) and

determining if a response to the message is to be generated at each of the selected ones of the plurality of e-business entities based upon the reviewing. (Col. 4, lines 29-31)

With regard to Claims 4,18,25 Mandler teaches the system & method comprising:

publishing the response to the service interface based upon the determining; (Col. 4, lines 29-31)

publishing the response to the broker by the service interface; and (Col. 4, lines 29-31)

publishing the response to the first entity by the broker. (Col. 4, lines 29-31)

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Bhat relating to a publish/subscribe method with the teachings of Mandler providing for the review of incoming messages and the response thereto. The motivation for such a combination can be found in both references. In Bhatt, the use of the publish/subscribe system is contemplated for the electronic commerce arts at (Bhatt, Col. 1, lines 24-28), which describes how the nature of business events triggers the system. As well, Mandler

suggest using improved computer technologies at (Mandler, Col.2, line 65 – Col. 3, line 12). An obvious business application is to publish responses to the RFQ's so as to consummate a transaction.

With regard to Claim 5,26 Mandler nor Bhat teach the method wherein:
the responding ones of the plurality of entities are each anonymous to the first entity.

The examiner takes Official Notice that anonymous publishing is old and well known in the art, and is a common occurrence in a publish/subscribe scenario. Therefore, it would have been obvious to one of ordinary skill in the art modify the teachings of Mandler to expressly include anonymous publishing. The motivation for such a combination is to expand the number of applications available to users of the system. Applicant has not traversed the noticed fact in Claims 5 and 26, and pursuant to MPEP §214.03(C), the Examiner considers as admitted prior art, the elements of Claims 5,26.

With regard to Claim 6, Mandler does not teaches the method comprising:
publishing the response directly to the first entity based upon the determining.

However, once the seller knows the identity of the buyer, an inherent part of the system is that the seller can then either continue to process the RFQ using the broker, OR if so inclined, initiate communication with the buyer directly. Mandler thus anticipates this claim as well.

With regard to Claim 7,27 Mandler specifically emphasizes that buyers and sellers need not have previously conducted business together. Even so, there is nothing in the disclosure that indicates the buyer or seller can not know each other. Thus

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inherent to the system is the idea that in some cases, the responding ones of the plurality of entities are each known to the first entity.

With regard to Claim 8, Mandler teaches the method comprising:

publishing the response to the service interface based upon the determining;
(Col. 4, lines 29-31)

publishing the response to the broker by the service interface; and
(Col. 4, lines 29-31)

With regard to Claim 9, Mandler specifically emphasizes that buyers and sellers need not have previously conducted business together. Even so, there is nothing in the disclosure that indicates the buyer or seller can not know each other. Thus inherent to the system is the idea that in some cases, the responding ones of the plurality of entities are each known to the first entity.

With regard to Claims 10,19,28 Mandler teaches a system and method wherein:

the message is a request for a quote (RFQ).
(Col. 7, lines 21-27)

With regard to Claims 11,20,29 Mandler teaches a system and method wherein:

the response is a quote.
(Col. 7, lines 39-40)

With regard to Claim 12,30 Mandler teaches a method wherein:

the first entity is included in a first enterprise computer system and wherein at least one of the responding entities is included in a second enterprise computing system.
(Col. 6, lines 22-40)

With regard to Claim 13,31 Mandler teaches a method wherein:

the first and the second enterprise computing systems are different enterprise computing systems. (Col. 6, lines 40-43)

With regard to Claim 14,32 Mandler does not expressly teaches a method wherein:

the first enterprise computing systems is an ebXML based enterprise computing system.

However, the examiner observes that unless the use of a specific operating system or programming language is *critical or uniquely required* for implementation of the claimed method, very little patentable weight is given to claims identifying one operating system or programming language.

Even so, the examiner observes that ebXML is more or less a framework for developing a business transaction vocabulary that is based on XML. Bhatt teaches using XML in its operation of a publish/subscribe system at (Col. 3, lines 50-57). As such, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to a publish/subscribe method based on XML. The motivation for such a combination is found in Mandler at (Col.2, line 65 – Col. 3, line 29) which suggests using improved computer technologies to reduce distribution cost, expand markets for sellers, and allow buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

With regard to Claim 15,33 Mandler does not expressly teach the method wherein:

the second enterprise computing systems is an ebXML based enterprise computing system.

However, the examiner observes that unless the use of a specific operating system or programming language is *critical or uniquely required* for implementation of the claimed method, very little patentable weight is given to claims identifying one operating system or programming language.

Even so, the examiner observes that ebXML is more or less a framework for developing a business transaction vocabulary that is based on XML. Bhatt teaches using XML in its operation of a publish/subscribe system at (Col. 3, lines 50-57). As such, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to a publish/subscribe method based on XML. The motivation for such a combination is found in Mandler at (Col.2, line 65 – Col. 3, line 29) which suggests using improved computer technologies to reduce distribution cost, expand markets for sellers, and allow buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

Conclusion

Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel, can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.


James M. Alpert
August 21, 2006


ELLA COLBERT
PRIMARY EXAMINER